



**MINISTRY OF INDUSTRY, FOREIGN TRADE AND SERVICES
NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY
DIRECTORATE OF PATENTS, COMPUTER PROGRAMS
AND TOPOGRAPHY OF INTEGRATED CIRCUITS**

**PPH INPI-JPO PILOT PROJECT:
PROCEDURE GUIDELINE**

Date: 31/03/2017

*This Guideline does not replace the text of the Resolution INPI PR n° 184, of
March 24, 2017, published at RPI n° 2412, of March 28, 2017.*

PPH INPI-JPO PILOT PROJECT

1 INTRODUCTION

This procedure guideline was prepared considering the Joint Statement of Intent on Patent Prosecution Highway (PPH) Pilot Project, hereinafter entitled PPH INPI-JPO, signed between the National Institute of Industrial Property of Brazil (INPI) and the Japan Patent Office (JPO) in São Paulo, Brazil, on March 16, 2017, by the organizations' representatives. This document aims to indicate the necessary procedures and requirements to enable a patent application to participate in the PPH INPI-JPO Pilot Project at the Brazilian office.

The PPH INPI-JPO is a priority examination modality. To participate in the INPI, a patent application of the same patent family must have been granted in the JPO and the applicant must comply with the requirements set forth in the Resolution INPI PR n° 184, of March 24, 2017, published in the RPI n° 2412. Frames 1, 2 and 3 demonstrate the types of PPH accepted. The PPH, through the exploitation of all the search/examination-related information of the OFF, supports applicants in their efforts to obtain stable patent rights efficiently around the world, reduces the search/examination burden and improves the quality of the examination of the major patent offices in the world¹.

Main characteristics for INPI requirements:

- a) Patent applications initiated in the INPI or the JPO;
- b) Patent applications filled via Paris Convention (CUP) or Patent Cooperation Treaty (PCT);
- c) Patent applications which a corresponding patent applications have undergone merit examination in the JPO (utility models do not undergo merit examination in the JPO);
- d) Only the decision to grant a corresponding patent application can be used as basis of prioritization;
- e) Applications for patents of invention and utility models filled with INPI may be prioritized.
- f) Patent applications classified in the "Information Technology" technical field (in accordance with item 2.1.3 of the Eligibility Requirements);
- g) Patent applications with any filing date;
- h) Restriction of the number of applications made by the same applicant for a certain period of time; and
- i) Specific fee collection (only at INPI).

¹ Source: <http://www.jpo.go.jp/pph-portal/aboutpph.htm>

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Frame 1: Example of PPH steps "Paris Route (CUP)" of "Type A"

1. The applicant applies the First Patent Application (patent application without priority). The office where this application is made is entitled "Office of First Filing" (OFF).
2. The applicant applies a Second Patent Application in another patent office and claims as priority the First Patent Application. Note that in this case, both applications belong to a patent family. This other patent office is entitled "Office of Second Filing" (OSF).
3. The Office of First Filing issues the first decision to grant a patent and becomes the "Office of Earlier Examination" (OEE). In this example, the OFF was the first to carry out the examination. In this case, the OFF is also the OEE. This is what defines this route as "Type A". Other cases are described in the other frames.
4. By definition, all the other offices where the patent application of the same family has been filled are named "Office of Later Examination" (OLE).
5. **This is the time when you can apply for PPH.** At the office that has not yet carried out the examination (OLE), the applicant may request participation in the PPH INPI-JPO pilot project for the application from the same family of the one already examined. In this case, the OSF is the OLE. To do so, it is necessary to comply with OLE legislation and:
 - a. Submit the OEE search and examination results;
 - b. Modify the claim framework to match the one granted in the OEE;
 - c. Attach a table showing the list of the claims granted in the OEE and the modified ones ("corresponding table"); and
 - d. Submit other mandatory documents.
6. If the documents presented are correct, the patent application will be able to participate in the PPH INPI-JPO pilot project and will have its examination prioritized.
7. Finally, the OLE examines the patent application from the same family of the one granted in the OEE, using the usual search and examination procedures and in compliance with the local legislation.

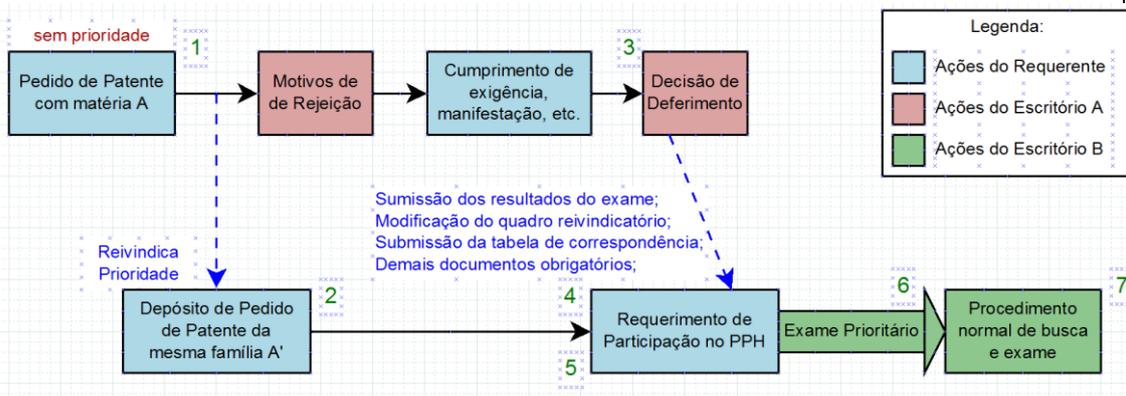


Figure 1: Example of PPH steps "Paris Route (CUP)" of "Type A"

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Frame 2: Example of PPH steps "Paris Route (CUP)" of "Type C"

1. The applicant applies the First Patent Application (patent application without priority). The office where this application is made is entitled "Office of First Filing" (OFF).
2. The applicant applies a Second Patent Application in another patent office and claims as priority the First Patent Application. Note that in this case, both applications belong to a patent family. This other patent office is entitled "Office of Second Filing" (OSF).
3. Any of the Offices of Second Filing issues the first decision to grant a patent and becomes the "Office of Earlier Examination" (OEE). In this example, the OSF was the first to carry out the examination. In this case, the OSF is the OEE. This is what defines this route as "Type C".
4. By definition, all the other offices where the patent application of the same family has been filled are named "Office of Later Examination" (OLE).
5. **This is the time when you can apply for PPH.** At the office that has not yet carried out the examination (OLE), the applicant may request participation in the PPH INPI-JPO pilot project for the application from the same family of the one already examined. In this case, the OFF is the OLE. To do so, it is necessary to comply with OLE legislation and:
 - a. Submit the OEE search and examination results;
 - b. Modify the claim framework to match the one granted in the OEE;
 - c. Attach a table showing the list of the claims granted in the OEE and the modified ones ("corresponding table"); and
 - d. Submit other mandatory documents.
6. If the documents presented are correct, the patent application will be able to participate in the PPH INPI-JPO pilot project and will have its examination prioritized.
7. Finally, the OLE examines the patent application from the same family of the one granted in the OEE, using the usual search and examination procedures and in compliance with the local legislation.

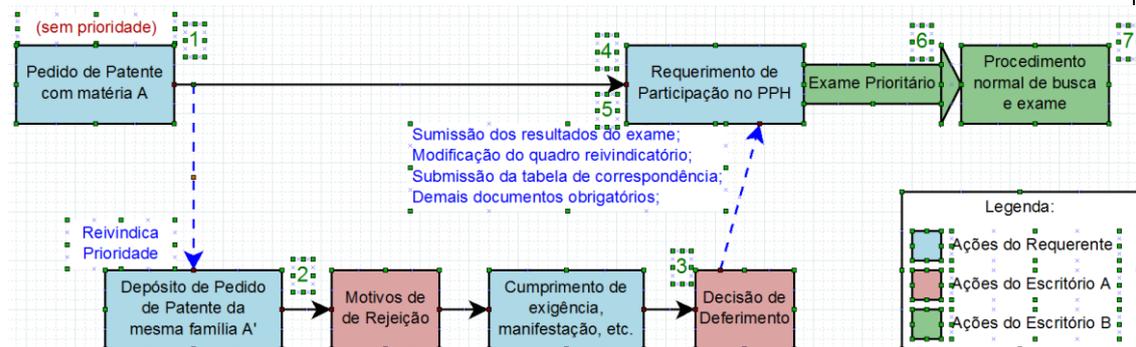


Figure 2: Example of PPH steps "Paris Route (CUP)" of "Type C"

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Frame 3: Example of PPH steps “Direct PCT Route”

1. The applicant applies the First Patent Application (patent application without priority) directly at the “Receiving Office” (RO), which in this case is the World Intellectual Property Organization (WIPO). Note that there is no OFF figure. This application directly in the RO nominates the route.
2. The application enters into national phase at the “Designated Offices” (DO). Note that in this case, all applications belong to a patent family. Also note that there is no OSF figure.
3. One of the Designated Offices issues the first decision to grant a patent and becomes the “Office of Earlier Examination” (OEE).
4. By definition, all the other offices where the patent application of the same family has been filed are named "Office of Later Examination" (OLE).
5. **This is the time when you can apply for PPH.** At the office that has not yet carried out the examination (OLE), the applicant may request participation in the PPH INPI-JPO pilot project for the application from the same family of the one already examined. To do so, it is necessary to comply with OLE legislation and:
 - a. Submit the OEE search and examination results;
 - b. Modify the claim framework to match the one granted in the OEE;
 - c. Attach a table showing the list of the claims granted in the OEE and the modified ones (“corresponding table); and
 - d. Submit other mandatory documents.
6. If the documents presented are correct, the patent application will be able to participate in the PPH INPI-JPO pilot project and will have its examination prioritized.
7. Finally, the OLE examines the patent application from the same family of the one granted in the OEE, using the usual search and examination procedures and in compliance with the local legislation.

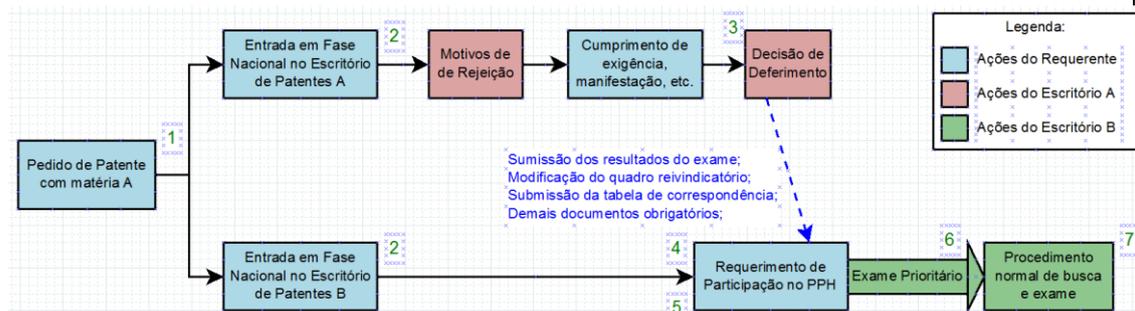


Figure 3: Example of PPH steps “Direct PCT Route”

2 ELIGIBILITY REQUIREMENTS

In order to participate in the PPH INPI-JPO pilot project, all the requirements described in articles 4th to 10 of the Resolution INPI PR n° 184, of March 24, 2017 must be fulfilled. The requirements are relative (i) to the patent application; (ii) to the content of the patent application; (iii) to the request for participation and (iv) to the applicant. Some irregularities can be regularized (corrected) until the evaluation of the request for participation by the evaluation committee.

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Note: The eligibility conditions for participation in the JPO are different. For example, patent applications classified at any technical field may participate of the PPH INPI-JPO pilot project at the Japanese office. **Information on how to apply for PPH in the JPO is available on the Japanese office website.**

Note: If you want the INPI to act as Office of Earlier Examination (OEE), the applicant can request any of the priority examination modalities available at the Institute - especially the Priority BR project. More information can be found on the website: <http://www.inpi.gov.br/menu-servicos/patente/accelere-seu-exame>.

2.1 Irreparable Eligibility Requirements of the Patent Application

Some requirements are considered "irreparable". That is, it is not possible for the applicant to correct the patent application to make it able to participate in the PPH INPI-JPO pilot project. The following patent application requirements are irreparable:

2.1.1 *To be an application for patent of invention or utility model*

The participation in the PPH INPI-JPO pilot project is conditional on the existence of an application for a patent of invention or utility model in progress at INPI. For additional information on the filing of patent applications, see the Patent Applicant's Handbook, which can be accessed on the website <http://www.inpi.gov.br/menu-servicos/patente/guia-basico-de-patente>.

Other types of industrial property, such as certificates of addition, trademarks and industrial design registrations, can not be prioritized using the PPH INPI-JPO pilot project.

2.1.2 *The patent application filled with the INPI, to which priority examination is required, must belong to the same patent family as the "base" patent application (patent application granted by the JPO)*

Within the PPH INPI-JPO pilot project, a patent family is considered as the "set of patent applications filled in more than one national patent office or international organization, in which all claim as Unionist priority, at least, the First Patent Application" (Resolution INPI PR n° 184, article 2nd, item XI). Such applications and patents may have been filed or granted in more than one national patent office or international organization (Frame 4:

Frame 4: Definition of patent family for PPH

A patent family is a set of patent applications or granted patents in more than one country to protect the same invention developed by the same inventors. A first patent application is filled in one country - the priority - and then it is extended to other offices.

A patent family has two types of patent applications. Those patent applications that do not claim priority are entitled "**First Patent Application**" or "**Document of Origin**" or, in special cases, "**Priority Document**". Only such documents are accepted as a priority document for filling a patent application at another national patent office or international organization. That is, only these documents are capable of originating a patent family. Those patent applications which, on the other hand, at the time of filling, claim the First Patent Application as priority are entitled "**Second Patent Applications**". Upon filling a Second Patent Application, the First Application is renamed "**Priority Document**." A general explanation about patent family can be given, considering Table 1.

Table 1: Patent family examples

Family F1	Patent Application A	Priority P1		
Family F1	Patent Application B	Priority P1	Priority P2	
Family F1	Patent Application C	Priority P1	Priority P2	Priority P3
Family F2	Patent Application D		Priority P2	
Family F2	Patent Application E		Priority P2	Priority P3
Family F3	Patent Application F			Priority P3
No family	Patent Application G			

Consider that the Priority P1 document is older (filled before) than P2; and that the Priority P2 document is older than P3. In this case, the Family F1 consists of 4 documents: the First Patent Application (or Priority P1) and the Second Patent Applications A, B and C, as they share at least the oldest priority P1. The Family F2 consists of 3 members: Priority P2 and Patent Applications D and E, as they share at least the oldest priority P2. The Family F3 consists of 2 members: Priority P3 and Patent Application F, as they share at least the oldest priority P3.

Although Patent Applications C and D share the same Priority P2, they **do not** belong to the same family, as they do not share the oldest priority (which in this case is P1). The same is valid for Patent Applications E and F, that **do not** belong to the same patent family because they do not share the older priority P2. Note also that Priority P2 and P3 documents **do not** participate in the family F1. The same occurs with the Priority P3 document that **does not** participate in the Patent Family F2. The document G has no family, as it is a First Patent Application and does not have priority.

2.1.3 Patent applications which matter claimed is related to the technical field of "Information Technology" and classified by the INPI in any of the IPC codes listed below, including their respective lower classification hierarchical levels

In order to meet this requirement, it is considered as being of the technical field of "Information Technology" the patent applications which main classification (first classification), according to the International Patent Classification (IPC), is one of the IPCs listed below.

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	Technical Field	IPC Codes
1	Machinery and electrical appliances , energy	F21#, H01B, H01C, H01F, H01G, H01H, H01J, H01K, H01M, H01R, H01T, H02#, H05B, H05C, H05F, H99Z
2	Audiovisual technology	G09F, G09G, G11B, H04N-003, H04N-005, H04N-009, H04N-013, H04N-015, H04N-017, H04R, H04S, H05K
3	Telecommunications	G08C, H01P, H01Q, H04B, H04H, H04J, H04K, H04M, H04N-001, H04N-007, H04N-011, H04Q
4	Digital communication	H04L
5	Basic communication processes	H03#
6	Computer technology	(G06# not G06Q), G11C, G10L
7	Methods of information technology for management	G06Q
8	Semiconductors	H01L
9	Miscellaneous	B60K, B60L, B60W, B62D, B62J, F02D, G02B, G02F, G03G, G08G, H01S, H04N19, H04N21, H04W, H05H

2.1.4 The patent family of the patent application must have started at the INPI or the JPO or, under the PCT, the RO/BR or the RO/JP

The first patent application is considered to be "patent application with priority right assured for filing with another national patent office or international organization as established by CUP; or international filing, under the PCT, without claim of priority" (Resolution INPI PR n° 184, article 2, item IX). For example, the first patent application of a patent family was filled with the INPI and this application was claimed as priority for a filing in the JPO.

It is important to consider that the first filing must be made with the INPI or the JPO or, under the PCT, the RO/BR or the RO/JP. That is, in the "Paris Route" the OFF must be the INPI or the JPO and in the "Direct PCT Route" the RO must be BR or JP. It is allowed that the application filled in the RO has one or more priorities. In this case, the oldest priority should be BR or JP.

2.1.5 The filling route of other applications can be via CUP or PCT

The three valid routes to participate in the PPH INPI-JPO pilot project are: "Paris Route (CUP)" of "Type A", "Paris Route (CUP)" of "Type C" and "Direct PCT Route". If you have questions about the steps of each route, refer to Frames 1, 2 and 3 above.

Note: The routes "Paris Route (CUP)" of "Type B" (which allows applications initiated in any country) and "PCT-PPH Route" (which accepts results from international search and/or examination) do not participate in the PPH INPI-JPO pilot project. Note that another office is allowed to act as the International Search Authority (ISA) or as the International Preliminary Examination Authority (IPEA), but this result will not be accepted to request PPH in the INPI.

2.1.6 The JPO, acting as OEE, granted a patent application of the same patent family

The patent family member was considered patentable by the JPO. Using the Japanese nomenclature, the JPO issued a "decision to grant". Only the "decision to grant" examination result is valid.

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Other examination results or examination results of other industrial property types may not be used as a basis for requesting participation in the PPH INPI-JPO pilot project at INPI.

2.1.7 Patent application that is not divided, except those resulting from the direct division of the original application and from the state of lack of unity of invention by the OEE in the corresponding application

The application may not be the original of a divided application nor the result of the division of another patent application. They are only accepted in cases where (i) the division occurred directly from the original application and (ii) resulted from the allegation of lack of invention unit or technical-functional unit done by the JPO. Note that it is necessary to comply with both provisions above, not just one of them. For example, applications that are a divisional application of other divisional applications are not accepted.

2.1.8 No other form of prioritization may have been granted to the patent application

Note: It is possible to request priority examination even if the patent application already has a technical examination opinion published in the Industrial Property Magazine (*Revista de Propriedade Industrial – RPI*). In this case, the other examination steps (for example, second examination and/or appeal) will be prioritized.

2.2 Repairable Eligibility Requirements of the Patent Application

The requirements listed above are considered "irreparable". On the other hand, there are requirements that are considered "reparable" because the applicant can correct them until the evaluation of participation in the PPH INPI-JPO pilot project. Participation in the priority examination of a patent application is conditional on fulfilling the following reparable requirements:

2.2.1 Patent application for which the dispatch codes of "Filled Patent Application or Certificate of Addition of Invention" or "Notification - National Phase - PCT" was published in the RPI, depending on the case

If the above dispatch codes have not yet been published in the RPI, the applicant must be aware of any demands formulated by the INPI for the fulfillment of requirements, mainly formal ones.

If the entry into the national phase has already been requested, even without its publication in the RPI, it is possible to request participation in the PPH INPI-JPO pilot project. However, the patent application will only be accepted in the project, if accepted in the national phase.

2.2.2 The application must have the international publication or be published in RPI

If the application has not yet been published, the applicant or his/her legal representative must generate the Union Collection Ticket (*Guia de Recolhimento da União - GRU*) for the "Early Publication" service, which has code 202, and pay the

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appropriate fee. The GRU can be generated on the website <http://formulario.inpi.gov.br/e-inpi/internetCliente/Principal.jsp>.

2.2.3 The examination of the patent application must have already been required

If the patent application has not yet had the examination request, the applicant or his/her legal representative must generate the GRU for the "Invention examination request" (service code 203) or "Utility Model examination request" (service code 204), and pay the appropriate fee. Both services are exempted from petition.

2.2.4 The examination can not be suspended to comply with a previously formulated demand

The progress of the patent application can not be suspended for regular process instruction, that is, to meet the formulated demand(s). If there is any demand, the processing of the patent application will be suspended. The applicant must be aware of any demands formulated by the INPI for its compliance, mainly the formal ones.

2.2.5 The application annual fee must be paid

In order to regularize the application with respect to the payment of the annual fees, the applicant or his/her legal representative must generate the GRU for the payment of "Patent application annuity fee", through codes 220 to 229, depending on the status of the application, and pay the appropriate fee. In the case of a utility model application, codes 240 to 247 shall be used, considering the status of the application.

2.2.6 The matter of the patent application can not be in legal dispute in Brazil

2.3 Eligibility Conditions of the Participation Request

In addition to the patent application requirements, the request for participation must be made in compliance with the following requirements:

2.3.1 The request for participation must be submitted and paid within the term of the PPH INPI-JPO pilot project (between 01/04/2017 and 31/03/2019)

Resolution INPI PR nº 184, of March 24, 2017, establishing the Pilot Project of Shared Examination PPH INPI-JPO, was published on March 28, 2017 with entry into force on 01/04/2017. The PPH INPI-JPO pilot project will receive participation requests until 31/03/2019. Applications considered eligible will be evaluated even after this deadline has expired.

2.3.2 The request for participation must be among the first 200 requests considered eligible to participate in the PPH INPI-JPO pilot project

The request for participation for other requests beyond the limit of 200 requests will be denied.

2.3.3 The request for participation must be made by at least one of the applicants of the patent application and/or one of their legal representatives

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If there is more than one applicant, the request may be made by either of them individually or jointly. It is also possible that any of the legal representatives of at least one applicant make the request for participation.

2.3.4 The request for participation must be one of the first six carried out by any of the applicants for the patent application in the four-month period

An applicant can make up to six participation requests every four-month period of the program (Figure 4). **This limitation does not apply in the last four-month period of the program (from 01/12/2018 to 31/03/2019).**

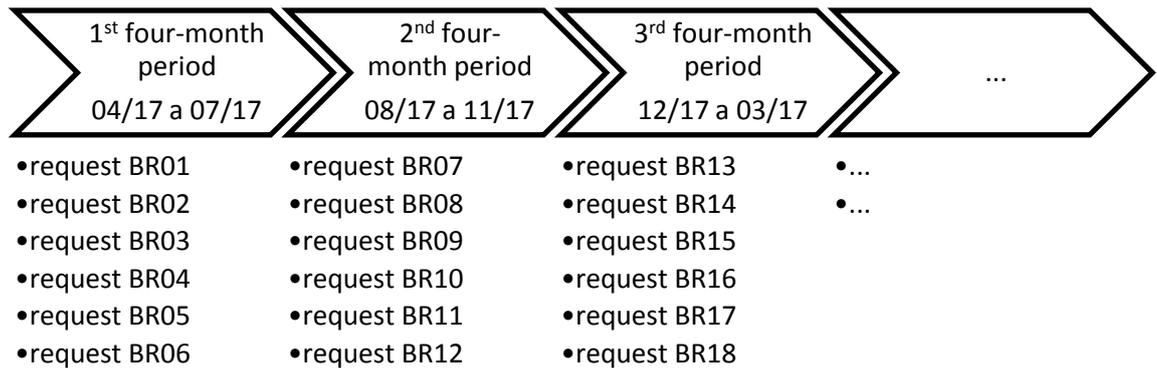


Figure 4: Number of participating applications per applicant

If a patent application has more than one applicant, it is considered that each one has already made one request for participation in the period. That is, if there is more than one applicant, it will count for both. For example, a particular patent application "BR01" has the applicant "A" and the applicant "B", and another patent application "BR02" has the applicant "B" and the applicant "C". In this case, if the applicants request the PPH for both applications, it will be considered that the applicant A and C had done one request each and that the applicant "B" has done two PPH requests.

The monthly cycle is counted from the first to the last day of the month. Thus, following the previous example, the applicant "B" can make six requests for participation on the last day of the four-month period beginning on 01/04/2017 (31/07/2017) and six other requests for participation on any day of the following month, for example, on the first day of the following four-month period (01/08/2017). **All other requests made by the same applicant within the same four-month period will not be recognized.**

All other requests made by the same applicant within the same month will not be accepted.

The monthly cycle is not extended if the due date is not a business day. For example, 30/04/2017 is a Sunday. The participation requests submitted on the next business day (01/05/2017) will be considered as made in May.

3 DOCUMENTS AND DECLARATIONS

To request the participation in the PPH INPI-JPO pilot project, some mandatory and other optional documents are required.

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3.1 Mandatory documents

To participate in the PPH INPI-JPO pilot project, the following mandatory documents are required:

3.1.1 Payment of specific fee

The Union Collection Ticket (*Guia de Recolhimento da União - GRU*) code 277 must be paid and the "PPH-JPO" service must be specified. It is not necessary to attach the GRU to the process.

3.1.2 Priority Examination Request Form

The form must be completed online and sent electronically to INPI through the electronic petition available on the INPI website at the link: <https://gru.inpi.gov.br/peticionamentoeletronico/>

3.1.3 Evidence that the patent application complies with the definitions of article 4 of Resolution INPI PR n° 184 of March 24, 2017

The applicant shall attach documents proving that the patent of invention application or the patent of utility model application (i) belong to a patent family which the first patent application was filed with the INPI or the JPO or, under the PCT, the BR/RO or the JP/RO; and (ii) the JPO granted a patent application of the same patent family.

These documents include (but are not limited to) form filled with the JPO, cover sheets of the patent applications publication, examination result made by the JPO.

3.1.4 Modified patent application to sufficiently correspond to the subject previously granted by the JPO for the application of the same family, respecting the normative instructions in force regarding the change of patent applications in the INPI

To request participation in the PPH INPI-JPO pilot project in the INPI, all the claims of the patent application filed with the INPI, if necessary, must be adapted to sufficiently match one or more of the claims considered by the JPO to be patentable (grantable).

It is considered "sufficiently corresponding claims" the ones "in which the subject matter claimed in the OLE [INPI] has equal or more limited scope than the matter considered patentable in the OEE [JPO], even considering differences due to translations of the claim" (Resolution INPI PR 184, of March 24, 2017, article 2, item XIX). For example, a claim is more restricted when it adds technical features supported by the patent application and limits the scope of protection.

The claims in the patent application filed with the INPI which introduce a new or different category in comparison with the patent application considered patentable by the JPO will **not** be considered sufficiently relevant.

It is not necessary to include all claims considered patentable by the JPO to request participation in the PPH INPI-JPO pilot project at the INPI. For example, in the case where the patent application contains five claims considered by the JPO to be patentable (grantable), the patent application to the INPI may contain only three of these five claims.

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The following are illustrative examples of "sufficiently corresponding claims".

Case	"Patentable or grantable" claims		Claims in the INPI		Explanation
	N°.	Content	N°.	Content	
Case 1	1	A	1	A	Claim 1 in the INPI is the same as "patentable or grantable" claim 1
Case 2	1	A	1	A+a	Claim 1 in the INPI has an "a" characteristic which clarifies or defines, limited to the initially disclosed.
Case 3	1	A	1	A	Claim 1 in the INPI is the same as "patentable or grantable" claim 1
			2	A+a	Claim 2 in the INPI describes the characteristic "A" and further details or defines with the characteristic "a" supported in the patent application
Case 4	1	A	1	A	Claim 1 in the INPI is the same as "patentable or grantable" claim 1
	2	A+a	2	A+b	Claim 2 in the INPI is the same as "patentable or grantable" claim 3
	3	A+b	3	A+a	Claim 3 in the INPI is the same as "patentable or grantable" claim 2

The following are illustrative examples of "claims which are **not** sufficiently corresponding".

Case	"Patentable or grantable" claims		Claims in the INPI		Explanation
	N°.	Content	N°.	Content	
Case 5	1	A Product	1	A' Method	Claim 1 in the INPI claims a method and the "patentable or grantable" claim 1 claims a product. The technical feature of the claim in the INPI is the same as that of the "patentable or grantable" claim, but the categories of both are different.
Case 6	1	A+B	1	A+C	Claim 1 in the INPI is different from the "patentable or grantable" claim 1 in a component of the claimed invention. The claim in the INPI creates or alters part of the technical characteristics of the "patentable or grantable" claims.

3.1.5 Correspondence table of the claims, evidencing the correlation between the amended claims submitted to the INPI and the claims considered patentable by the JPO as OEE or, in the case of the claims presented to the INPI constitute a mere translation of the claims of the same family granted by the JPO, statement of this condition

The correspondence table should show possible differences between the claims considered patentable by the JPO and the amended claim frame submitted to the INPI. See the template in Table 2. Remember that the scope of the claim frame must be equal

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or more restricted and that the modifications must comply with the examination guidelines.

Table 2: Example of correspondence table of the claim frame

Claim granted in the JPO	Modification of the claims table presented at the INPI	Comments
1	1	Claim 1 presented to the INPI corresponds to the simple translation of claim 1 considered patentable in the JPO.
2	2 e 3	Claim 2 granted in the JPO has been dismembered in claims 2 and 3 filed with the INPI to comply with the legislation.
3 e 4	4	Claims 3 and 4 granted in the JPO were grouped in claim 4 filed with the INPI to comply with the legislation.
5	5	Claim 5 granted in the JPO corresponds to claim 5 filed with the INPI restricted with addition of the text segment...

If the modified claim frame presented to the INPI corresponds to a simple translation of the claims granted in the JPO, the applicant is not required to present the correspondence table, simply stating that the claim frame corresponds to a translation.

3.1.6 Declaration that the patent application is not in legal dispute in Brazil

3.2 Other Documents

Some documents are mandatory in special cases.

In the event of a technical examination report of the OEE citing non-patent documents of the state of the art, it is necessary to present a copy of them with the request for participation.

In the event that the object of the patent application is derived from access to the sample of Brazilian genetic heritage component or associated traditional knowledge, the patent application process must have the information required by the current legislation.

If there is a legal representative of the applicant(s), it is necessary to attach a simple copy of the proxy of each applicant.

Note: The statements required to participate in the PPH INPI-JPO pilot project are included in the Patent Prosecution Highway - PPH Pilot Project Request Form. It is therefore not necessary to submit the declarations in a separate document.

Note: Although the PPH INPI-JPO pilot project is paid, it is not necessary to attach the payment voucher to the request form.

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4 REQUEST FOR PARTICIPATION

The examination prioritization service must be requested by at least one of the applicants or their representative of the patent application during the term of the project.

In order to request the PPH INPI-JPO priority examination, the applicant or his/her legal representative must, firstly, generate the GRU referring to service code 277 on the website <http://formulario.inpi.gov.br/e-inpi/internetCliente/Principal.jsp>. When asked which type of priority collaborative examination is desired, "PPH-JPO" should be chosen.

In order to proceed with the Priority Examination Request, the applicant or his/her legal representative must use the Priority Examination Request Form. The form must be completed electronically on the website <https://gru.inpi.gov.br/peticionamentoeletronico/>.

In the "Interested" section of the Priority Examination Request Form, the applicant must fill out his/her data. It is emphasized that only the applicant can request the priority examination in this pilot project, that is, third parties can not request this service.

In the "Reference" section of the Priority Examination Request Form, the applicant must provide information on the patent of invention or utility model application for which priority examination is sought. The nature of the application (whether patent of invention or utility model) must be indicated, as well as the number and date of filing of the application.

The "Prosecutor" section of the Priority Examination Request Form must be filled in if there is a legal representative of the applicant. In addition, the designated prosecutor must indicate in the "Attached Documents" section the "Proxy" box and attach a simple copy of the proxy to the form. If there is no legal representative, this field should be left blank.

In the "Attached Documents" section of the Priority Examination Request Form, the applicant must select all the mandatory documents. In this case, the form must be submitted to the INPI together with a digital copy of the indicated documents.

In addition, the applicant may attach other related documents.

Note: If you wish to attach other documents that are not included in the list of documents described in the "Attached Documents" section, you are requested to use a specific form and pay the GRU for the service. Specifically, if the application refers to genetic resources or associated traditional knowledge, form FQ011 for information of the authorization number of access (CGEN authorization) (service code 264), or form FQ012 for Negative Declaration of Access (CGEN) (service code 273), must be submitted. Service codes 264 and 273 are exempt from payment.

5 PROCESS FLOW

The application date for entry into the PPH INPI-JPO pilot project corresponds to the receipt date of the priority examination electronic request form.

The evaluation of the Priority Examination Request will be made by the Directorate of Patent, Computer Programs and Topography of Integrated Circuits (DIRPA). At first, the analysis of the requirements will follow the chronological order of the request date for the service, but the INPI may postpone the analysis until the

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applicable irregularities of the request are exceeded. In this case, the order will obey the moment of publication by the INPI of the corresponding dispatch code.

During the analysis of the participation requirements, the INPI may request the applicant (i) copy of one or more search reports and technical examinations reports made by the JPO; (ii) copy of prior art documents cited by the JPO in its technical examination reports; (iii) copy of the action made by the JPO, as OEE, determining the matter subject to patent protection; (iv) copy of the claim frame considered by the JPO to be patentable; (v) copy of any applicant statements with the JPO; and/or (vi) copy of the action made by the JPO, as OEE, granting the corresponding patent application. If requested, the applicant will have 60 days to regularize the process, under penalty of the request discontinuance.

The INPI will notify in the RPI the allowance of priority examination of patent application, through the publication of dispatch code 28.1 and, when denied, through the publication of dispatch code 28.2. The technical opinions of the priority examination will be made available to the public in the INPI *e-Parecer* system (<http://eparecer.inpi.gov.br/eparecer.php>).

If allowed, the priority examination will be initiated after 60 (sixty) days from the request publication. After this period, the patent application will be sent to the competent patent division to carry out the substantive examination. The applicant must monitor and follow up in the RPI the technical examination for his/her patent application, which is exclusive responsibility of the user.

If the request for priority examination is denied, the applicant may submit one single new Priority Examination Request, only in cases where the INPI points out that there are reparable irregularities. The deadline for submitting the new request is 60 days. The applicant must remedy the irregularities pointed out by the INPI, being exempted from resubmitting any documents, for which no irregularities were pointed out.

New requests for priority examination in the context of the PPH INPI-JPO pilot project, regulated by the Resolution INPI PR n° 184, of March 24, 2017, will not be accepted in cases where (i) the pilot project deadline has expired; or (ii) the maximum number of requests stipulated for the project has been reached.

The decisions of the evaluation committee may be appeal, except for those that denied the participation of the patent application: (i) in disagreement with article 219 of Law 9,279 of 1996; (ii) the decision was based on the lack of presentation of documentation or its presentation beyond the deadline set forth in the Resolution INPI PR n° 184, of March 24, 2017; (iii) the decision was based on incomplete or incorrect presentation of one or more documents and information required in the Resolution INPI PR n° 184, of March 24, 2017; and (iv) the requirements set forth in Article 6 of the Resolution INPI PR n° 184, of March 24, 2017 were not met prior to the evaluation by the technical committee.

6 MERIT EXAMINATION

The PPH INPI-JPO pilot project does not change the basic principle of the independence of rights established by art. 4bis of the Paris Convention (CUP). This means that the PPH INPI-JPO pilot project does not exempt the applicant from complying with the Industrial Property Law of Brazil (LPI) for patent applications filled with INPI, and

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that the examination of the patent application will be carried out in accordance with Brazilian law and respecting the other procedures in force at the examination date.

As in the analysis of the participation requirements, during the merit examination, the INPI may also request the applicant (i) copy of one or more search reports and technical examinations reports made by the JPO; (ii) copy of prior art documents cited by the JPO in its technical examination reports; (iii) copy of the action made by the JPO, as OEE, determining the matter subject to patent protection; (iv) copy of the claim form considered by the JPO to be patentable; (v) copy of any applicant statements with the JPO; and/or (vi) copy of the action made by the JPO, as OEE, granting the corresponding patent application. These copies must be in Portuguese, English or Spanish, or be translated (simple translation) into one of these languages, at the discretion of the applicant. If requested, the applicant will have 60 days to regularize the process, under penalty of the request discontinuance.

7 ADDITIONAL INFORMATION

Additional information on the PPH INPI-JPO pilot project are available in Resolution INPI PR n° 184, of March 24, 2017 which governs the topic. For general information about PPH see the PPH portal: http://www.jpo.go.jp/ppph-portal/index.htm?utm_source=twitterfeed&utm_medium=twitter. For information on the agreement signed between INPI and JPO, see the Joint Statement of Intent: <http://www.inpi.gov.br/menu-servicos/patente/projeto-piloto-pph>. If necessary, please contact us via the link: <http://faleconosco.inpi.gov.br/faleconosco>.